

REMARKS/ARGUMENTS

Prior to entry of this Amendment, the application included claims 1-5, 7, 9, 11-15, 17, 18, 21 and 23. No claims have been amended, canceled or added. Hence, after entry of this Amendment, claims 1-5, 7, 9, 11-15, 17, 18, 21 and 23 stand pending for examination.

Claim 18 stands rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-5, 7, 9, 11-15, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,397,194 to Houvener et al. ("Houvener") in view of the cited portions of U.S. Patent Publication No. 2001/0029470 to Schultz et al. ("Schultz").

Claims 21 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shultz.

Rejections Under 35 U.S.C. § 101

Claim 18 remains rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter. The Office Action states that "the Examiner has interpreted the 'means for' functionality in the claims broadly to correspond to software program elements." This is a fatal flaw in the rejection. While broad interpretation of claims may be appropriate for the purpose of applying prior art, it is improper to do so for the purpose of evaluating whether a claim is directed to statutory subject matter. The Applicant submits that because there exists an interpretation of claim 18 that is statutory, the rejection is improper.

Rejections Under 35 U.S.C. § 103

The Applicant respectfully requests reconsideration of the rejections under 35 U.S.C. § 103(a).

The Applicant maintains that the rejection of claim 18 is improper. The Office Action cites Thompson as teaching user-defined categories, yet the Office Action states that “the user-defined categories are those selected by the user.” User-selected categories are not, however, user-defined categories. Having to torture user-selected categories to include user-defined categories is a good indication that it was improper to take official notice of the claim element; having to cite multiple columns of a reference are another. Official Notice is not intended to be a default rejection when a claim element cannot be found in the prior art. As stated at MPEP § 2144.03,

“Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While “official notice” may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of **instant and unquestionable demonstration** as being well-known. (Emphasis Added)

The rejection of claim 18 is, therefore, improper.

The rejection of claims 1 and 21 is improper because the Office Action has not cited a reference for “receiving from the consumer computer information that defines at least one user-defined category based on product information.” The Office Action does not give the claim element patentable weight. In justifying the rejection, the Office Action states, “[t]he limitation ‘information that defines at least one user-defined category based on product information’ is not a positive recitation of the defining step. This limitation describes the information received from the consumer computer and not the step of receiving the information.” This makes no sense. The only way the claim element could be interpreted as not describing the step of receiving the information is because the Office Action has conveniently parsed the claim element to remove the “receiving” part of the claim. As the Applicant pointed out previously, the user-defined categories are usable to sort the items and in fact are so used, as indicated in another claim element. Hence, it is improper not to give the claim elements patentable weight.

All claims are believed to be allowable for the additional reason that one of skill in the art would not be motivated to combine the references. Houvener teaches away from Schultz since Houvener requires paper receipts (see Houvener, col. 6, ll. 59-60) and Schultz deals exclusively with electronic environments (see, for example, the Abstract, and paragraphs 3, 10, 29 and 31, among others, of Schultz). Hence, any hint of a motivation to combine the references is destroyed by this teaching away. All pending claims are, therefore, believed to be allowable, at least for this additional reason.

The Applicant maintains that the cited references could not be successfully combined to produce a working embodiment of the Applicant's claimed invention. Houvener relates to scanning paper receipts. Schultz deals exclusively with electronic environments. There is no receipt generated by Schultz to be scanned by Houvener. Moreover, the Office Action's attempt to explain the combination has not addressed the flaw in the argument that there is no teaching that allows Houvener to interface with Schultz, so the system produced by the combination would fail to function properly. Hence, all pending claims are believed to be allowable, at least for this additional reason.

Conclusion

In view of the foregoing, the Applicant believes all claims now pending in this application are in condition for allowance and an action to that end is respectfully requested.

Application No. 10/615,582
Amendment dated April 28, 2008
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 3691

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Date: April 28, 2008

/Irvin E. Branch/

Irvin E. Branch

Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP

Two Embarcadero Center, Eighth Floor

San Francisco, CA 94111-3834

Tel: 303-571-4000

Fax: 415-576-0300

IEB/jln

61307149 v1